shalll be withdrawn and claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application.

Claims 47-50 have been amended herein merely to correct technical and grammatical informalities and to more particularly point out the subject matter that applicants regard as the invention. Full §112 support for these amendments can be found in the specification on page 3, lines 4-13, page 5, lines 14-22, and page 6, lines 1-4. No new matter has been added by the amendments. The amendments do not raise any new issues and thus, do not necessitate any additional search of the art by the Examiner.

II. Priority

The specification was amended to identify the instant application as a continuation of Application No. PCT/GB99/01136, filed April 14, 1999 in the application transmittal letter filed October 12, 2000. A copy of this document is enclosed with this Response for the Examiner's convenience. Applicants do not believe that an amendment to the specification to indicate the status of the PCT application should be required.

The Examiner has acknowledged applicant's claim for foreign priority based upon application No. 98-7935.3 filed on April 14, 1998 in the United Kingdom. A certified copy of the foreign application is filed herewith and thus fulfils the requirement under 35 U.S.C. § 119(b).

III. The Specification

The Examiner has objected to the specification because it does not contain an abstract of the disclosure as required by 37 C.F.R. § 1.72(b). Applicants have amended

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

the specification to include an abstract on a separate sheet as required. Thus, the objection to the specification should be withdrawn.

IV. The Oath/Declaration

The Examiner has objected to the oath/declaration as allegedly defective for failing to identify the citizenship of each inventor, or the city and state or foreign country of residence of each inventor. The Examiner further alleges that the declaration does not include the signature of each inventor.

Applicants respectfully submit that the Examiner is mistaken and have provided, with this Response, a courtesy copy of the declaration as filed in response to the Notice to File Missing Parts dated December 18, 2000. The declaration is signed by both inventors. It indicates that the citizenship of inventor Smith is Great Britain and the citizenship of inventor Li is China and that the residence of both inventors is Edinburgh. Thus, the declaration is in full compliance with 37 C.F.R. § 1.67(a) and the objection should be withdrawn.

V. The Rejection Under 35 U.S.C. § 112

Claims 47-51 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Applicants have amended claims 47-49 to correct the minor clerical error contained in those claims. As a result of the amendment, claims 47-51 cannot be considered indefinite and the rejection should be withdrawn.

The Examiner has objected to the phrase "a culture substantially of individual cells" in claim 50. The Examiner alleges that the metes and bounds of "substantially"

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

are unclear, thus rendering the claim indefinite under 35 U.S.C. § 112. Without conceding the correctness of the Examiner's rejection and for the sole purpose of expediting prosecution, applicants have amended claim 50 to replace the phrase "substantially of" with "comprising", thus obviating the rejection.

VI. The Rejection Under 35 U.S.C. § 102

Claims 42-54, 58 and 64 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Li *et al.* 1998, *Current Biology* 8:971. This rejection is in error and applicants respectfully request that it be withdrawn.

The publication date of Li is August 1998. The priority date of the instant application is April 14, 1998. Applicants have now perfected their priority claim by filing a certified copy of the priority application. Thus, Li is not prior art to the instant application and the rejection based on Li must be withdrawn.

VII. The Rejection Under 35 U.S.C. § 103

Claims 42 and 64 stand rejected under 35 U.S.C. § 103 as allegedly unpatentable over Li *et al. supra* in view of Merryman, (1997) U.S. Patent No. 5,629,145. Applicants traverse.

As stated above, Li is not prior art. Merryman merely discusses a method of cryopreservation of a cell suspension. To establish a *prima facie* case of obviousness the prior art reference must teach or suggest all of the claim limitations of the instant invention. M.P.E.P. § 2143. Merryman does not teach all of the claim limitations of either claim 42 or 64 and thus does not establish a *prima facie* case of obviousness. Merryman does not teach or suggest a method of generating a culture that is purified or

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

enriched in respect of cells of a selected lineage and thus, clearly does not render claim 42 obvious.

Claim 64 depends on claim 42 and recites a method of preparing a neural progenitor cell or differentiated progeny thereof for storage. Merryman does not teach or suggest a neural progenitor cell or differentiated progeny thereof and therefore does not render claim 64 obvious. Accordingly, the rejection of claims 42 and 64 under 35 U.S.C. § 103 should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Applicants do not believe that any extension of time is required for entry of this Response and Amendment. However, if this is an error, please grant any extension of time required to enter the response and charge any required fees to deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 21, 2002

By: E Stewart Mittler
E. Stewart Mittler
Reg. No. 50,316

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

MARKED UP VERSION OF AMENDED CLAIMS

47. (Amended) A method according to [any of] Claim 42 wherein the selectable marker is introduced into the multipotential cell by targeted integration or random gene trap integration so as to be operatively coupled to a gene that is differentially expressed in progenitor cells of the selected lineage.

48. (Amended) A method according to [any of] Claim 42 wherein the selectable marker is introduced into the multipotential cell via random integration of a transgene in which the selectable marker is operatively coupled to a gene that is differentially expressed in progenitor cells of the selected lineage.

49. (Amended) A method according to [any of] Claim 42 wherein the multipotential cell is an ES, EG or EC cell and the method comprises forming an embryoid body, or otherwise inducing differentiation of the cells.

50. (Amended) A method according to Claim 49 wherein the differentiated cells are dissociated so as to form a culture [substantially of] comprising individual cells.

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000